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OFFICE OF PETITIONS

In re Application of	:
Ilya Schiller et al.	:
Application No. 09/832,340	: DECISION ON PETITION
Filed: April 10, 2001	: UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. 19965-004001	:

This is a decision on the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed April 1, 2008, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of priority to the prior-filed non-provisional and provisional applications set forth in the concurrently filed amendment.

The petition is **DISMISSED**

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

This pending nonprovisional application was filed on April 10, 2001, within twelve months of the filing date of the prior-filed provisional application, Application No. 60/195,491, which was filed on April 10, 2000, and for which priority is claimed. However, the instant non-provisional application was filed more than 12 months after the filing dates of provisional applications 60/096,988 and 60/142,200 and thus cannot properly claim the benefit of their earlier filing dates under 35 USC 119(e). Furthermore, 35 USC 111 (b) (7) stipulates "A provisional application

shall not be entitled to the right of priority of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) of this title”.

37 CFR 1.78(a)(2)(i) requires that any non-provisional application claiming the benefit of one or more prior-filed copending non-provisional applications must not only contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed non-provisional application. An example of a proper benefit claim is: “This application is a continuation of Application No. 10/---, filed---.” A benefit claim that merely states: “This application claims the benefit of Application No. 10/---, filed---,” does not comply with 37 CFR 1.78(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each non-provisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent non-provisional application. *See* MPEP Section 201.11, *Reference to Prior Non-provisional Applications*. In the amendment to the specification, filed April 1, 2008, the benefit claim pertaining to the non-provisional applications 09/376,837 and 09/698,471 is initially stated without specifying the relationship of the ‘837 and ‘471 applications to the instant application. The inclusion of the relationship in question later on in the amendment is confusing and therefore unacceptable.

Additionally, the amendment is not acceptable as drafted since it also improperly incorporates by reference the prior-filed application(s). An incorporation by reference statement added after an application’s filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 119(e) after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 119(e) is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

Also, 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) require a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. Since the statement appearing in the petition varies from the required language, the statement is being construed as the statement required by 37 CFR §§ 1.78(a)(3) and 1.78(a)(6). If this is not a correct reading of the statement appearing in the petition, petitioner should promptly notify the Office.

Before the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition and either an Application Data Sheet or a substitute amendment (complying with the provisions of laws and regulations noted above) to correct the above matters are required.

As authorized, the \$1410 fee required by 37 CFR 1.78(a)(6)(ii) has been charged to petitioner's Deposit Account No. 06-1050.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
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By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

Any questions concerning this matter may be directed to Ramesh Krishnamurthy at (571) 272-4914.


David Bucei
Petitions Examiner
Office of Petitions

CC: David L. Feigenbaum
 Fish & Richardson P.C.
 225 Franklin Street
 Boston, MA 02110

Applicant : Ilya Schiller et al.
Serial No. : 09/832,340
Filed : April 10, 2001
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Attorney's Docket No.: 19965-004001

Amendments to the specification:

Please replace the paragraph beginning at page 1, line 3 with the following amended paragraph:

This application claims the benefit of the filing dates of United States Provisional Patent Application 60/195,491, filed April 10, 2000, United States Provisional Patent Application 60/096,988, filed August 18, 1998, United States Provisional Patent Application 60/142,200, filed July 1, 1999, United States Patent Application 09/376,837, filed August 18, 1999, and United States Patent Application 09/698,471, filed October 27, 2000, both all incorporated here by reference. This application is a continuation in part of United States Patent Application 09/698,471, filed October 27, 2000[[.]], which is a continuation in part of United States Patent Application 09/376,837, filed August 18, 1999.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Ilya Schiller et al. Art Unit : 2624
Serial No. : 09/832,340 Examiner : Brian Q. Le
Filed : April 10, 2001
Title : USING HANDWRITTEN INFORMATION

MAIL STOP PETITIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR 1.78(A)(3) FOR DELAYED CLAIM UNDER 35 USC 120

Please accept the applicant's unintentionally delayed claim under 35 USC 120 for the benefit of a prior-filed application. This petition is accompanied by an amendment in reply to an office action. The amendment includes the reference required by 35 USC 120 and 37 CFR 1.78(a)(2) to the prior-filed application.

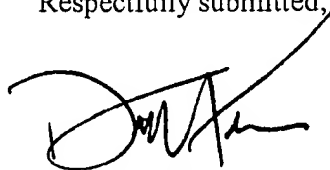
The entire delay between the date this claim was due under 37 CFR 1.78(a)(2)(ii) and the date of filing this claim was unintentional.

Please charge any fees due in connection with this petition, including the surcharge under 37 CFR 1.17(t), or make any credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

4/1/8



David L. Feigenbaum
Reg. No. 30,378

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906